

REMARKS

I. Statement

A personal Examiner interview was held on December 8, 2004. Applicant expresses his appreciation to Examiners Kishore and Fubara for their attention to this matter at the interview. During the interview, Applicant's representatives first stated that claims 1-7, 18-20, 23, 24, 26, 28, 39, 40-46, 48, 50, 56 and 58-61 would be cancelled. Only method claims would remain after the above-listed claims are cancelled. Therefore, the rejections under 35 U.S.C. § 102(b) in view of Russian Application No. RU 2034465 (RU 2034465) and PCT Application No. WO 96/04943 (WO 96/04943), both to Pavlyk, would be moot, except for method claim 47.

Currently pending independent claim 9 was discussed in view of U.S. Patent No. 6,335,028 to Vogel *et al.* (Vogel). The Applicant's representatives explained that the Application is directed to a pliable hydrogel that takes the shape of the cavity in which it is administered, e.g., implanted or injected. Vogel, however, discloses solid microparticles that maintain their shape when implanted and a liquid suspension of the microparticles. See Vogel, Col. 6, ll. 20-23 and Col. 6, ll. 52-55. To further underscore this distinction, Applicant's representatives proposed an amendment to claim 9 to include language stating that the hydrogel has a complex viscosity of about 2 to 90 Pas, which provides for a colloidal solution. While Vogel does not disclose complex viscosity of his solid microparticles, if complex viscosity of his microparticles could be measured, it would likely be significantly greater than 90 Pas due to their solid state.

Dr. Kishore, the Primary Examiner, also pointed out that the claim 9 could read on oral administration of capsules and other orally-ingested formulations for administering the hydrogel. While Applicant disagreed with that assertion, to expedite prosecution, Applicant proposed that "endoprosthesis" be included in the amendment to claim 9. Applicant's representatives pointed out that currently pending claim 18 claims a "prosthetic device" which should have been included in previous searches. Dr.

Kishore, however, stated that a subsequent search would have to be performed. Dr. Kishore further noted that the amended claim 9 (set forth above) would be allowable so long as the search produces no substantive results that defeat patentability of claim 9.

Finally, Applicant's representatives raised the issue of obviousness-type double patenting rejections. The Applicant's representatives stated that the copending applications claim compositions and methods unrelated to incontinence. Dr. Kishore and Ms. Fubara agreed to reconsider the double patenting rejections.

II. Amendment

Reconsideration of rejections in the Application is respectfully requested. Applicant cancelled claims 1-7, 18-20, 23, 24, 26, 28, 39-46, 48, 50, 56 and 58-61 without prejudice and to expedite prosecution. Applicant reserves all his rights to pursue protection for the subject matter of all cancelled claims in future patent applications. Upon entry of the foregoing amendment, claims 9-17, 29-38, 47, 49, 51-55, 57 and 62-64 will be pending. Claims 9-15, 17, 29-38, 47, 49, 51-55 and 57 stand rejected. Claim 16 is objected to. Claims 9, 10 and 54 are amended. New claims 62-64 are added.

Applicant respectfully requests entry of the above amendment and submit that the amendment does not introduce new matter. Support for the amendment to the claims and for new claims can be found throughout the specification (considered as a whole) and in the claims as originally filed. In particular, support for the amendment to claim 9 can be found, *inter alia*, in claim 9 as originally filed and in the specification at page 5, lines 1-2 and 17-19; page 10, lines 9-11; and page 11. Support for the amendment to claim 54 can be found, *inter alia*, in the specification at page 5, lines 17-19. New claims 62-64 are directed to more detailed aspects of the invention, support therefor being found in the specification, considered as a whole, e.g., page 6, lines 19-20 and page 10, line 18. No new issues are raised by claims 62-64 since substance of those claims has been recited in the claims examined during pendency of this

application, e.g., see original claims 1 and 14. Furthermore, the addition of these new claims does not increase the total number of claims (in view of cancellation of a greater number of claims). For at least these reasons, entry into the record and consideration on the merits of claims 62-64 is respectfully requested.

Based on the above amendments and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

III. Claim Rejections

Claims 1-7, 18, 20, 26, 28, 41-46 and 50 stand rejected under 35 U.S.C. § 102(b) as being anticipated by RU 2034465. Claims 1, 3, 5, 6, 18, 20, 26, 41, 46, 47 and 50 stand rejected under 35 U.S.C. § 102(b) as being anticipated by WO 96/04943. Claims 1-7, 9-15, 18-20, 23, 24, 26, 28-36 and 41-61 stand rejected under 35 U.S.C. § 103(a) as being obvious over Vogel. Claim 16 is objected to as being dependent upon a rejected base claim.

Claims 1-7, 9-15, 18-20, 23, 24, 26 and 28-49 are provisionally rejected under obviousness-type double patenting as being unpatentable over claims 1-35 of copending Application No. 09/938,668 and claims 1-42 of copending Application No. 09/928,669. Claims 1-7, 9-15, 17-20, 23, 24, 26 and 28-49 are provisionally rejected under obviousness-type double patenting as being unpatentable over claims 1-40 of copending Application No. 09/938,670.

Rejections under 35 U.S.C. § 102(b).

Claims 1-7, 18, 20, 26, 28, 41-46 and 50 stand rejected under 35 U.S.C. § 102(b) as being anticipated by RU 2034465. Claims 1, 3, 5, 6, 18, 20, 26, 41, 46, 47 and 50 stand rejected under 35 U.S.C. § 102(b) as being anticipated by WO 96/04943. As stated above, claims 1-7, 18-20, 23, 24, 26, 28, 39-46, 48, 50, 56 and 58-61 are cancelled. Therefore, the rejections are rendered moot. Claim 47 is also not

anticipated by WO 96/04943 at least because the reference fails to disclose a method for treating incontinence or vesicouretal reflux.

Rejections under 35 U.S.C. § 103(a)

Claims 1-7, 9-15, 18-20, 23, 24, 26, 28-36 and 41-61 stand rejected under 35 U.S.C. § 103(a) as being obvious over Vogel. The rejections of claims 1-7, 18-20, 23, 24, 26, 28, 41-46, 48, 50, 56 and 58-61 are rendered moot because the claims are cancelled.

Independent claims 9 and 54, from which all other claims depend, have been amended to include a recitation of complex viscosity. This recitation further distinguishes the solid microparticle or liquid suspension of microparticles of Vogel from the claimed hydrogel of the Application at least because Vogel does not teach or suggest the use of a hydrogel having the claimed complex viscosity of 2 to 90 Pas. In contrast, Vogel teaches solid microparticles. Therefore, the rejections over Vogel should be withdrawn as indicated by the Primary Examiner in the interview.

Objection

Claim 16 is objected to as being dependent upon a rejected base claim. The objection should be withdrawn because claim 9 from which claim 16 depends should be allowable based upon the above amendment and remarks.

Double Patenting

Claims 1-7, 9-15, 18-20, 23, 24, 26 and 28-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of copending Application No. 09/938,668 (the '668 Application) and claims 1-42 of copending Application No. 09/928,669 (the '669 Application). Claims 1-7, 9-15, 17-20, 23, 24, 26 and 28-49 are provisionally rejected

under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of copending Application No. 09/938,670 (the '670 Application).

Applicant decided to amend the claims in the '668 Application and will do so shortly. Once such claims are amended, the '668 Application will claim a method for replacing, mimicking or augmenting a function of cartilage, synovial fluid or both. This clearly does not render obvious the claims that will be pending in the Application (i.e., methods for treating incontinence or vesicoureteral reflux).

Applicant has already submitted amendments to the claims in the '669 Application and the '670 Application. The claims that will be pending in the '669 Application are directed to a prosthetic device for soft tissue augmentation. The claims that will be pending in the '670 Application are directed to a bio-stable hydrogel for use as an endoprosthesis. These claims also will not render obvious the methods for treating incontinence or vesicoureteral reflux as claimed in the Application.

Therefore, Applicant respectfully requests that the obviousness-type double patenting rejections be reconsidered as agreed by the Primary Examiner in the interview, and subsequently be withdrawn.

Other Matters

At pages 5-6, miscellaneous matters were addressed relating to claim 1 (and claims dependent from claim 1). Since claim 1 is cancelled, such matters are moot.

CONCLUSION

For at least the reasons stated above, claims 9-17, 29-38, 47, 49, 51-55, 57 and 62-64 are in condition for allowance. Accordingly, Applicant respectfully requests that the Application be allowed and passed to issue.

In the event any outstanding issues remain, Applicant would appreciate the courtesy of a telephone call to Applicant's undersigned representative to resolve such issues in an expeditious manner.

This Amendment is filed within the three-month shortened statutory period for reply. Therefore, it is believed that no fees are due. However, in the event it is determined by the PTO that fees are due, the Commissioner is authorized to charge such fees to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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